

REMARKS

This communication responds to the Office Action of July 25, 2008, in which the Examiner rejected claims 1, 2, 4-7, 10, 24 and 25 under 35 U.S.C. § 112. Reconsideration and allowance are requested at least for the reasons discussed below.

Rejections under 35 U.S.C. §112

Claims 1, 2, 4-7, 10, 24 and 25 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is traversed at least for the following reasons.

The Examiner asserts:

The amended claim 1 now recites the new limitation of “solidifying the immobilizing medium to provide a solidified mass of bone and immobilization.” However, this new limitation is not supported by the instant specification because the specification discloses solidifying the immersed bone and its immobilization medium as originally claimed (see page 3, lines 4-5, and rather than solidifying the immobilizing medium alone as current claimed. Therefore, the amendment contains new matter.

Current Office Action, page 2-3. The Applicants first note that the complete claim limitation as presented in the previous office action is “solidifying the immobilization medium to provide a solidified mass of bone and immobilization medium.” As may be appreciated by one skilled in the art, the bone is immersed, which indicates that the quantity of bone immersed in the immobilization medium is solid. More specifically, the bone is provided in a solid form and is retained in a solid form throughout the method of making bone particles. Accordingly, the claim amendment is intended merely to clarify that it is solidification of the immobilization medium that leads to “a solidified mass of bone and immobilization medium,” as claimed.

Support for the claim language cited by the Examiner may be found at paragraph [0044] of the specification as published (US 2006/0024656):

The bone, fully mineralized or demineralized as described above, is immersed in an immobilization medium. The immobilization

medium is then solidified to form a solidified mass comprising the embedded bone.

Specification as filed, p. 8, ll. 22-24. Given the specific support for the claimed language of “solidifying the immobilization medium to provide a solidified mass of bone and immobilization medium,” as recited by claim 1, the Applicants respectfully submit that this language is does not constitute new matter.

In making his rejection, the Examiner cites to a portion of the summary of the invention restating claim 1 as originally drafted. The Applicants respectfully note that the specification should be considered as a whole and, thus, the portion of the specification cited above (paragraph [0044] should be considered. However, to expedite prosecution of the application, the portion of the specification referenced by the Examiner has been amended to clarify that it is the immobilization medium that is solidified to provide a solidified mass of bone and immobilization medium. The Applicants respectfully submit that this amendment is not new matter and merely is an obvious clarification to the specification. As previously noted, one skilled in the art would appreciate that bone is solid as immersed in the immobilization medium and need not be further solidified. Such amendment is permitted, as provide in MPEP 2163.07:

An amendment to correct an obvious error does not constitute new matter where one skilled in the art would appreciate not only the existence of error in the specification, but also the appropriate correction. In re Oda, 443 F.2d 1200, 170 USPQ 260 (CCPA 1971) (change from nitrous to nitric acid in examples directed to methods of preparing a claimed compound was not new matter since error and correction would be apparent to one skilled in the art); Ex parte Brodbeck, 199 USPQ 230 (Bd. App. 1977).

MPEP 2163.07.

The Applicants thus respectfully submit that the claims do not include new matter and are thus allowable. Claims 2, 4-7, 10, 24 and 25 were also rejected because they depend from claim 1. These claims are allowable for the same reasons discussed with respect to claim 1, from which they depend. Withdrawal of the rejections under 35 U.S.C. 112 are thus respectfully requested.

CONCLUSION

This application now stands in allowable form and reconsideration and allowance is respectfully requested.

This response is being submitted on or before December 29, 2008 (December 25-26 being USPTO holidays, and Dec. 27-28 being a weekend), with the required fee for a two-month extension of time, making this a timely response. It is believed that no additional fees are due in connection with this filing. However, the Commissioner is authorized to charge any additional fees, including extension fees or other relief which may be required, or credit any overpayment and notify us of same, to Deposit Account No. 04-1420.

Respectfully submitted,

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